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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/573,692	03/27/2006	Pascale Lacan	ESSR:111US	7189		
32425	7590	01/07/2009	EXAMINER			
FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701				ROBINSON, ELIZABETH A		
ART UNIT		PAPER NUMBER				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/573,692	LACAN ET AL.	
	Examiner	Art Unit	
	Elizabeth Robinson	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 November 2008.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 19-44 is/are pending in the application.
 4a) Of the above claim(s) 23,24 and 44 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 19-22 and 25-43 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 27 March 2006 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2-21-2007, 1-29-2008</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I, claims 19-43 in the reply filed on November 21, 2008 is acknowledged.

Claim 44 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 21, 2008.

Applicant's election with traverse of metal fluoride as the species for the outer layer in the reply filed on November 21, 2008 is acknowledged. The traversal is on the ground(s) that the metal fluorides, metal oxides and metal hydroxides all share a corresponding special technical feature. This is not found persuasive because the outer coating material is not a "special technical feature" because Ohlin (US 5,792,537) teaches one of the outer layer species (marking ink). Applicant has not provided proof or stated on the record that the metal fluorides, metal oxides and metal hydroxides are obvious variants of each other.

The requirement is still deemed proper and is therefore made FINAL.

Claims 23 and 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 21, 2008.

Information Disclosure Statement

References B13 (FR 2856056) and C3 (Kimm Institute Report) were not considered. The references are not in English and there is no concise explanation of the relevance of these documents. Further, Reference C3 is blurry and unintelligible.

It is noted that, while considered, References A19 (US 5,582,907), A25 (US 6,364,823), A26 (US 6,413,413) and A29 (US 6,884,432) do not seem to pertain to the subject matter of the instant application. Similarly, it is unclear what relevance the title page and portion of the Table of Contents, provided as Reference C5 (Advanced Organic Chemistry), has to the instant application.

Claim Objections

Claim 39 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.
Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 39 depends from claim 40, which in turn depends from claim 39. In order to further prosecution, the Examiner is interpreting claim 39 to depend from claim 38.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19-22 and 25-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 19, the layer structure as written is unintelligible. The outer protective coating comprises what is claimed to be an outer layer, however this layer is coated with a peelable film and thus, is not an outer layer in the claimed structure. All other claims depend from claim 19 and are thus, also rendered indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19, 20 and 33-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohlin (US 5,792,537).

Regarding claims 19 and 20, Ohlin teaches an optical lens with a marking formed from a removable ink (protective coating that has an outer layer that is mechanically alterable through friction and/or contact) formed on the lens surface and then covered with a removable mask (Ohlin, claim 1). The preferred material for the mask is a static cling vinyl (Column 6, lines 33-45).

Regarding claims 33-36, Ohlin (Column 6, lines 33-45) teaches that the plastic material film is preferably a polyvinyl chloride film that contains 49 to 57 percent plasticizer.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 19-22, 25-36 and 38-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conte et al. (WO 03/057641), in view of Ohlin (US 5,792,537).

Regarding claims 19-22, 25, 26, and 33-36, Conte (Page 3, line 29 through Page 4, line 6) teaches an ophthalmic lens comprising a temporary protective layer. The temporary protective layer can be formed from MgF₂ (Page 6, lines 16-24). The temporary protective layer can be removed by dry wiping (Page 10, lines 25-29). The lenses comprising the temporary coating can be marked with inks used by the man in the art for progressive lenses (Page 11, lines 10-12).

Conte does not teach coating the protective layer with a peelable film.

Ohlin (Column 3, lines 26-50) teaches a mask that is adhered over markings on the surface of a lens to protect the markings from removal during subsequent processing. One use of these markings is to ensure that progressive lenses are

properly aligned (Column 2, lines 10-32). The preferred material for the mask is a static cling polyvinyl chloride film that contains 49 to 57 percent plasticizer.

It would be obvious to one of ordinary skill in the art to use the mask of Ohlin, over the ink markings of Conte, in order to ensure that the marking are protected from removal during subsequent processing.

Regarding claim 27, Conte (Page 6, lines 3-5) teaches that the inorganic (mineral) protective layer has a preferable thickness of 5 to 200 nm.

Regarding claim 28, Conte (Page 8, lines 31-34) teaches that the protective layer has a surface energy of at least 15 mJoules/m².

Regarding claims 29 and 30, Conte (Page 6, lines 1 and 2) teaches that the protective layer is preferably continuous.

Regarding claim 31, Conte (Page 6, lines 32 and 33) teaches that the temporary protective layer can have multiple layers.

Regarding claim 32, Conte (Page 7, lines 20-22) teaches that the protective layer can be formed by vapor phase deposition.

Regarding claim 38, Conte (Page 6, lines 16-19) teaches that the protective layer is coated on a hydrophobic and/or oleophobic surface coating.

Regarding claims 39 and 40, Conte (Page 4, lines 29-34) teaches that the hydrophobic and/or oleophobic surface coating preferable has a surface energy lower than 12 mJoules/m².

Regarding claims 41 and 42, Conte (Page 5, lines 17-22) teaches that the hydrophobic and/or oleophobic surface coating preferably has a thickness from 2 to 5 nm.

Regarding claim 43, Conte (Page 4, line 25-28) teaches that the hydrophobic and/or oleophobic surface coating is generally applied to lenses comprising an antireflecting coating.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohlin (US 5,792,537), in view of Mascarenhas et al. (US 5,888,615).

Regarding claim 37, as stated above, Ohlin teaches a lens that meets the limitations of claim 19 and states that it is preferred that the plastic material film is a polyvinyl chloride cling film.

Ohlin does not explicitly state the thickness of the film.

Mascarenhas (Column 2, lines 1-15) teaches that most cling films are vinyl chloride films that comprise 50-55 weight % plasticizer and have thicknesses from about 0.004 to 0.014 inches (101 to 355 microns).

The thickness of the film of Ohlin either meets the thickness limitation of the instant claim or it would be obvious to one of ordinary skill in the art to use a film with a thickness that has been shown to be effective for cling films as taught by Mascarenhas.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Robinson whose telephone number is (571)272-7129. The examiner can normally be reached on Monday- Friday 8 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Lawrence Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. R./
Elizabeth Robinson
Examiner, Art Unit 1794

/D. Lawrence Tarazano/
Supervisory Patent Examiner, Art
Unit 1794

December 17, 2008